

REMARKS

Applicant submits this Preliminary Amendment for consideration in conjunction with a Request for Continued Examination (RCE), and a request for a two-month extension of time. In this Preliminary Amendment, Applicant has amended claims 7, 28, 35, and 42. After entry of this paper, claims 7-13, and 28-47 will remain pending in this application.

To further prosecution, Applicants also responds to the Final Office Action dated August 9, 2006, and comments made in the Advisory Action dated December 4, 2006. In the Final Office Action, the Examiner (i) rejected claims 7, 10 - 11, and 13 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,047,242 granted to Benson ("Benson"); and (ii) rejected claims 8 - 9, 12, and 28 - 47 under 35 U.S.C. §103(a) as being unpatentable over Benson in view of U.S. Patent No. 6,009,543 to granted to Shavit ("Shavit").

Claim Rejections Under 35 U.S.C. §102(e)

The Examiner rejects claims 7, 10 - 11, and 13 as being anticipated by Benson. In order for a claim to be rejected under 35 U.S.C. §102, "[a]n 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention." See *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1372, 68 USPQ2d 1857, 1861 (Fed. Cir. 2003). Benson does not teach all of the limitations of the instant claims, therefore it cannot anticipate the claims, and the Applicant respectfully traverses.

Regarding claim 7, Benson does not teach "a challenge generator that selects, based at least in part on the credential, at least one predetermined portion of the application, the predetermined portion of the application including at least some executable software code, and issues a challenge requesting a response from the insecure arrangement, the response providing a computation of at least one value based on the selected predetermined portion of the application," as recited in claim 7. In the Advisory Action, the Examiner bases the rejection of claim 7, at least in part on, fact that the claim does not recite software code. It should be noted that claim 7 has been amended to recite "executable software code."

In contravention to the Examiner's assertion in the Advisory Action, the keyfile is *not* executable software code. Benson's keyfile is a file that contains the "customer's public [key] . . . along with thousands of decoy bits." *Benson*, col. 11, lines 14-21. While the keyfile might contain "hidden information concerning *selective activation of services* of the [program]," *Benson*, col. 17, lines 5-8 (emphasis added), Benson does not teach including any executable software code in the keyfile. That Benson specifically mentions including "hidden information concerning *selective activation of services* of the [program]," (emphasis added) indicates merely that Benson teaches including mechanisms, such as single-byte flags, that would indicate to executable software code (already at the customer's computer and not included as part of the keyfile), that the executable software code is permitted to perform certain actions such as "Print service" or "Save-On-Disk" service. *Benson*, col. 17, lines 9-10. Further, Benson teaches that the program "read[s] the keyfile . . . to determine the services that [executable software code already extant on the customer computer] should execute."

Benson, col. 17, lines 12-14. If Benson's program reads the keyfile to determine what services it is should execute, then clearly the portions of the program related to the services are already extant in the program at the customer computer and are not included as part of the keyfile. Moreover, executable software code comprises instructions for actions to be taken by a computer or other machine. The keyfile, on the other hand is not a set of instructions, but instead is a set of data usable by executable software code.

Further, as noted in the parent application, Benson teaches "a challenge means" that communicates with a "license server." In order to validate that Benson's license server has access to its purported private key, the challenge means challenges the license server using the license server's public key. *Benson, col. 12, lines 21 to 38.* There is no teaching of "select[ing] . . . at least one predetermined portion of the application . . . including at least some *executable software code*, and issu[ing] a challenge requesting a response, the response providing a computation of at least one value based on the selected predetermined portion of the application," (emphasis added) as recited in claim 7. The challenge means in Benson does not create anything based on any portion of the application, let alone "at least one predetermined portion of the application . . . including at least some executable software code" selected "based at least in part on the credential," as recited in claim 7.

Given the arguments above, it is clear that Benson does not teach one or more elements of claim 7. Therefore, Benson does not anticipate claim 7.

The Examiner rejected claims 10, 11, and 13 as anticipated by Benson. Each of these claims depends directly from claim 7 and therefore are patentable for at least the

reasons stated above with respect to claim 7. Each of the claims is also separately patentable. The Applicant will forego arguing each claim separately here, but reserves the right to argue the patentability of each claim in the future.

Claim Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 8 - 9, 12, and 28 - 47 under 35 U.S.C. § 103 as being unpatentable over Benson in view of Shavit. As noted in the Manual of Patent Examination Procedure (MPEP) § 2143, an obviousness rejection must “establish a prima facie case of obviousness [based on] three basic criteria . . . First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

The Examiner has not met the burden for proving a prima facie case of obviousness. Even if the references were properly combinable, however, a combination of Benson and Shavit would not teach or suggest all of the elements of the claims. Therefore, the Applicant respectfully traverses these rejections.

Regarding claims 8 - 9 and 12, each of these claims depends directly or indirectly from claim 7 and therefore incorporate all of the features of claim 7. As noted above, claim 7 is patentable over Benson for at least the reason that Benson does not teach “a challenge generator that selects, based at least in part on the credential, at least one predetermined portion of the application, the predetermined portion of the application

including at least some executable software code, and issues a challenge requesting a response from the insecure arrangement, the response providing a computation of at least one value based on the selected predetermined portion of the application," as recited in claim 7. Combining Benson with Shavit does not remedy this deficit.

The closest aspect of Shavit to the features noted above is Shavit's disclosure of selecting which portions of the program will run on a lessee's computer and which portions of the program will run on the vendor's computer. *Shavit*, col. 11, lines 49 - col. 12, line 18. Even this section, however, does not teach "a challenge generator that selects, based at least in part on the credential, at least one predetermined portion of the application, the predetermined portion of the application including at least some executable software code, and issues a challenge requesting a response from the insecure arrangement, the response providing a computation of at least one value based on the selected predetermined portion of the application," as recited in claim 7 and inherited in claims 8 - 9 and 12. In particular, there is no teaching in Shavit of "challenge requesting a response . . . [that] provid[es] a computation of at least one value based on the selected predetermined portion of the application . . . including at least some executable software code." Shavit simply teaches housing different portions of code on vendor and lessee computers in order to retain control over lessees' ability to run code. *Shavit*, col. 11, lines 49 - col. 12, line 18.

Further, in combination Benson and Shavit do not teach anymore than do the references separately. As the combination of Benson and Shavit does not teach at least one feature of claims 8 - 9 and 12, then a combination of the two does not render these claims obvious. Each of claims 8 - 9 and 12 are patentable for other reasons as

well and Applicant reserves the right to argue these patentability arguments at a later time.

Regarding claims 28, 35, and 42, each of these claims recites issuing “a challenge . . . requesting the application or agent to provide one or more cryptographic hashes of one or more portions of the application, the one or more portions of the application including at least some executable software code.” The combination of Benson and Shavit does not teach at least this feature.

As noted above in the discussion of claim 7, Benson, at its best, teaches “a challenge means” that communicates with a “license server” in order to validate that the license server has access to its purported private key by challenging the license server using the license server’s public key. *Benson*, col. 12, lines 21 to 38. Further, as noted in the Advisory Action, Benson also teaches “The challenge means calculates $h(k.r.sub.B, B)$ and compares the result (for equality) against the corresponding value received in Step (2). If the equality check succeeds, then the challenge mechanism accepts the proof, otherwise, the challenge mechanism rejects the proof.” *Benson*, col. 13, lines 35 - 39. The value used by Benson is “shared keying material k ,” *Benson* col. 13, line 26, such as a public key, *Benson*, col. 4 lines 48-56. The shared keying material, such as a public key, is not executable software code, as recited in claims 28, 35, and 42. Therefore, Benson does not teach “a challenge . . . requesting the application or agent to provide one or more cryptographic hashes of one or more portions of the application, the one or more portions of the application including at least some executable software code,” as recited in claims 28, 35, and 42.

Shavit also does not teach “a challenge . . . requesting the application or agent to provide one or more cryptographic hashes of one or more portions of the application, the one or more portions of the application including at least some executable software code,” as recited in claims 28, 35, and 42. As noted above in the discussion of claims 8 - 9 and 12, Shavit teaches selecting which portions of the program will run on a lessee’s computer and which portions of the program will run on the vendor’s computer. *Shavit*, col. 11, lines 49 - col. 12, line 18. There is no discussion in Shavit of issuing “a challenge . . . requesting the application or agent to provide one or more cryptographic hashes of one or more portions of the application, the one or more portions of the application including at least some executable software code” as recited in claims 28, 35, and 42.

Combining Benson and Shavit does not remedy the deficits pointed out above. Specifically, Benson and Shavit together do not teach “a challenge . . . requesting the application or agent to provide one or more cryptographic hashes of one or more portions of the application, the one or more portions of the application including at least some executable software code,” as recited in claims 28, 35, and 42. As a combination of Benson and Shavit does not teach at least one feature of claims 28, 35, and 42, a combination of the two references does not render the claims obvious.

Each of claims 29 - 34, 35 - 41, and 43 - 47 depend directly or indirectly from claims 28, 35, or 42, and therefore are patentable for at least the reasons stated above with respect to the corresponding independent claim. Each of the claims is also separately patentable. The Applicant will forego arguing each claim separately here. Applicant, however, reserves the right to argue the patentability of each in the future.

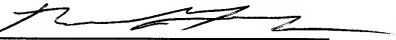
Conclusions

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art. Applicant therefore requests reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fees due in connection with the filing of this Preliminary Amendment, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

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Filed Via - EFS WEB